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09/313,278	05/18/1999	DAVID M. GOLDENBERG	018733/916	3688

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FOLEY & LARDNER  
SUITE 500  
3000 K STREET NW  
P O BOX 25696  
WASHINGTON, DC 200078696

EXAMINER

RIMELL, SAMUEL G

ART UNIT	PAPER NUMBER
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2175

DATE MAILED: 01/09/2004

*2p*

Please find below and/or attached an Office communication concerning this application or proceeding.

*M*

# Office Action Summary

Application No.

09/313,278

Applicant(s)

GOLDENBERG, DAVID M.

Examiner

Sam Rimell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 39-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**SAM RIMELL**  
**PRIMARY EXAMINER**

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Response to Requirement for Restriction: In applicant's response of October 24, 2003, Group I claims 39-51 were elected for examination. Applicant presented a traverse of this requirement, arguing that the language of non-elected claim 52 defines a type of server configured to perform specific tasks. While this argument is factually correct (the claimed server does perform the claimed functions) it does not consider the fact that the claim allows for other functions to be performed. In other words, claim 52 is open ended, and does not state that the claimed functions are the only functions that are allowed to be performed, it states that the claimed functions are the minimal functions that must be performed. Since the server apparatus in claim 52 is a standard computer system, it can perform other functions that those which are explicitly claimed. As a result, the server apparatus in claim 52 can perform other materially different functions than those described in the method claims 39-51. Hence the restriction requirement is proper, and made Final .

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 39-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Douglas et al. (U.S. Patent 6,039,688).

Claim 39: FIG. 1 illustrates a patient and a physician connected to a system interface (18). Any communication made by the physician or patient to the system interface is considered

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an inquiry from a user. The physician and patient can access different services, with each service being considered a "level of service".

(I) First level of service: Col. 14, lines 38-52 describe a first level of service. The "user sophistication" in this case is the number of points that the user earns for participating in the system. The system thus determines the user sophistication by keeping a record of the points for each user. The searching of the database in this case is the searching of the record in the computer system containing user's number of accumulated points and identifying the accumulated points. The results of the search are delivered to the user by allowing the user to view the information (col. 14, line 40).

Claim 40: (II) Second level of service: Col. 16, lines 21-55 describe a second level of service, in which searches are made on the database (computer system) in order to locate "more information", such as a list of articles and internet sites. (III) Third level of service: FIG. 48 illustrates a third level of service in which a user (Fred) is provided with a list of healthcare professionals (Susan). The user (Fred) is referred to the health professional (Susan) via the on-line conferencing arrangement of FIG. 48. (IV) Fourth level of service: Col. 17, lines 51-60 outline a fourth level of service in which the physiological condition (vital signs, blood pressure, weight) are monitored. Col. 6, lines 7-13 outline the administration of treatment by ordering that the patient take certain medications or participate in support groups.

Claims 41-43: The method steps defined by Douglas et al. meet each of parts (A), (B) and (C) defined in claim 40.

Claim 44: The levels of service may be accessed in any order. For example, the user can perform a search of articles and Internet sites (Second Level) before having an on-line meeting

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with health professional (Third Level of Service). After a given period of time, the user can take recommended medications or participate in support groups (Fourth Level of Service) , such as the next day after meeting with the health professional.

Claims 45-47: The method steps defined by Douglas et al. meet each of parts (B) and (C) as defined in claim 40.

Claim 48: FIG. 57 of Douglas et al. illustrates a utilization review system. The user preference is the norm established for the percentage of patients which are desired to be using the system (The listed norm is 17.3%). The weighing function is the measurement of each physician's percentage of patients who participate in the program. The physicians are thus ranked by the percentage of the patients under their supervision who participate in the program. The selection of the user is the designation of which physicians are on the list shown in FIG. 57.

Claim 49: The method of Douglas et al. includes step (C) from claim 40.

Claim 50: As described at col. 6, line 7-13, the user can be instructed via the system to take a medication. These are the telemedicine signals sent to the patient. The implanted device is thus whatever drug the user is asked to take and which releases chemicals into the body.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas et al. in view of Official Notice.

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Claim 51: Within the system of Douglas et al., the user can be asked remotely to take medication, but is not asked to undergo surgery. However, Examiner takes Official Notice that the concept of having a physician ask a patient to undergo surgery is very well known in the context of physician - patient interaction. It would therefore have been obvious to one of ordinary skill in the art to modify Douglas et al. to include a recommendation to the remote patient that the patient undergo surgery so as to improve the patient's health and prevent or eliminate disease as is well known in the art.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.

A handwritten signature in black ink, appearing to read 'Sam Rimell', with a stylized, cursive script.

Sam Rimell  
Primary Examiner  
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